

REMARKS

Favorable reconsideration of the present patent application is respectfully requested in view of the foregoing amendments and the following remarks. As a preliminary matter the Applicant expresses his appreciation for the indication of allowable subject matter in claims 9 and 20. However, it is believed that the other pending claims are allowable for the reasons discussed below.

In this Amendment no claims are added or canceled, and claims 7-12 and 22 are amended. As a result, claims 1-22 remain pending in the application.

In the non-final Office Action of October 10, 2006, claim 22 is rejected under 35 U.S.C. §112, second paragraph. Claims 7-12 are rejected under 35 U.S.C. §101. Claims 1-6, 17-19 and 21-22 are rejected under 35 U.S.C. §103(a) in view of U.S. Patent Application 2002/0229768 (Kawano) and further in view of allegedly Admitted Prior Art (APA). Claims 7-8 and 10-12 are rejected under 35 U.S.C. §103(a) in view of allegedly APA and further in view of Kawano. Claims 13-16 are rejected under 35 U.S.C. §103(a) in view of Kawano and further in view of allegedly APA with U.S. Patent Number 6,779,109 (Stevens) presented as an evidentiary reference). Claims 9 and 20 contain allowable subject matter.

35 U.S.C. §112 Second Paragraph Rejection

First, it is noted that U.S. patent practice does not require that all terms used in the claims derive antecedent basis from the specification under either §112 first paragraph, §112 second paragraph, or another other U.S. statute or rule. This is clearly set forth in the Manual of Patent Examining Procedure:

The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.¹

In drafting claim 22 it was believed that the use of the term “first contents” (accessible by the user) and the term “second contents” (from the HPA) provided the clearest, most straightforward claim language. Apparently the Office disagrees. Therefore, in an effort to be responsive to the Office Action the claim has been amended to use the terms “user accessible contents” and “copied contents of the protected area.”

Accordingly, withdrawal of the rejection is respectfully requested.

35 U.S.C. §101 Rejection

Claims 7-12 have been amended to attend to the §101 rejection. The claims now recite a “signal-bearing storage medium.” Accordingly, withdrawal of the §101 rejection is requested.

35 U.S.C. §103 Rejections

The §103(a) rejections of claims 1-6, 17-19 and 21-22 in view of Kawano and alleged APA and claims 7-8 and 10-12 in view of alleged APA and Kawano are respectfully traversed.

As discussed in the specification, various embodiments of the present invention allow data stored on a first storage device to be backed up by copying contents of a protected area (e.g., HPA) to an unprotected user area, and then saving the user area contents to a second storage

¹ MPEP §2173.05(e)

device—including the copied contents of the protected area. This ensures that the data from the protected area, in addition to the data from the user area, is backed up. By doing this a user can be sure that the data can be retrieved from the second storage device if the first storage device is damaged, lost or otherwise inaccessible.

The system described in the Kawano application backs up data by transferring it from the user area into the HPA of the same hard disk drive—*not to another storage device*. Then, according to Kawano, if the software stored on the user area becomes damaged or unstable the back-up copy of the data can be retrieved from the HPA area. This operation of the Kawano system is clearly explained:

When saved, the data is passed from the environment of the operating system (OS) 22 to the PARTIES partition, or when it is necessary to recover data, the data is passed from the PARTIES partition to the environment of the operating system (OS) 22.²

From this it is clear that the claimed invention operates in a different manner than the system discussed in the Kawano patent application. Kawano archives data by passing it from the user area to the protected area. The present invention archives data by copying it from the user area to another disk. Moreover, the data which is archived in the present invention includes data from the user area and data from the protected area (which has been copied on to the user area). According to Kawano the data is only moved from the HPA area into the user area when the software in the user area becomes unstable. Since the user area data is unstable, it seems unlikely that anyone would want to back it up onto another disk along with a copy of the HPA data—as the Office is apparently proposing in its interpretation of the Kawano patent.

Traversal of Inherency in the §103 Rejection

The Office's allegation that Kawano inherently teaches features of claim 1 and claim 8 is respectfully traversed. The Manual of Patent Examining Procedure sets forth the standard for inherency as follows:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.³

The Office contends that Kawano inherently copies contents of the protected area to the user area. But this is not necessarily the case, and thus the allegation of inherency is improper. The Kawano device backs up user area data by storing it in the protected area. If the user area data becomes corrupted or lost, the back-up data in the protected area can be retrieved. It may be the case that the user area of the disk itself gets damaged, for example, because the read/write heads have scratched the surface of the disk in the user areas. In such a situation the Kawano device would not copy the back-up data from the protected area to the user area, since the user area is damaged. Therefore, because the Kawano device does not necessarily copy the back-up data on to the user area, the aforementioned feature cannot be considered inherent. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference."

For at least these reasons, the Kawano patent does not teach or suggest "copying contents of a protected area of a first storage device to a user area of the first storage device." Moreover,

² Kawano, paragraph 37. See paragraphs 36-39.

³ MPEP §2112.

the Kawano patent does not teach or suggest “saving the user area to a second storage device,” since the Kawano devices backs up data within the protected area.

Accordingly, the Kawano patent application and the so-called APA, either taken singly or as a hypothetical combination, do not teach the features of the claimed invention. Therefore, withdrawal of the §103 rejections is requested.

35 U.S.C. §103 Rejections

The §103(a) rejections of claims 13-16 in view of the Kawano patent, alleged APA and the Stevens patent is respectfully traversed.

The Office Action, at page 10, notes that the so-called APA mentions that users sometimes backup their storage devices to backup storage devices. The Office Action then states that it would have been obvious to have backed up the user partition data to second storage device so that data can be retrieved in case of damage to the first storage device. This is not necessarily true. The Kawano device backs up data from its user area to a protected area of the first storage device, thus teaching away from backing up data to a second storage device.

As discussed above in the traversal of inherency, the Kawano patent does not teach or suggest “copying contents of a protected area of a first storage device to a user area of the first storage device.” Moreover, the Kawano patent does not teach or suggest “saving the user area to a second storage device,” since the Kawano devices backs up data within the protected area. Accordingly, the Kawano patent application and the so-called APA, either taken singly or as a hypothetical combination, do not teach the features of the claimed invention. Therefore, withdrawal of the §103 rejections is requested.

Deposit Account Authorization / Provisional Time Extension Petition

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-0439 and please credit any excess fees to such deposit account.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. However, in the event there are any unresolved issues, the Examiner is kindly invited to contact applicant's representative, Scott Richardson, by telephone at (571) 748-4765 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,



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